

REMARKS

Claims 1 – 30 are currently pending and stand restricted under 35 U.S.C. 121 into the following three groups as defined in the Office Action:

- I. Claims 1 – 30, drawn to antisense to human neuropilin gene, including SEQ ID NO:33, and compositions comprising said antisense and methods of using said antisense, classified in class 536, subclass 23.1 and 24.5.
- II. Claims 1 – 23 and 25 – 30, drawn to antisense to rat neuropilin gene, including SEQ ID NO:34, and compositions comprising said antisense and methods of using said antisense, classified in class 536, subclass 23.1 and 24.5.
- III. Claims 1 – 23 and 25 – 30, drawn to antisense to mouse neuropilin gene, including SEQ ID NO:35, and compositions comprising said antisense and methods of using said antisense, classified in class 536, subclass 23.1 and 24.5.

The Examiner asserts that the inventions of Groups I, II and III are unrelated under MPEP § 806.04 and MPEP § 808.01 as they have different modes of operation. The Examiner has indicated that the sequence of the rat, human and mouse neuropilin genes are known to be structurally different in the art and are patentably different gene sequences. The Examiner has alleged that the design of antisense to the different target genes are, therefore, also patentably distinct because design of antisense is dependent on the sequence structure of the target gene and the antisense would have patentably distinct sequence structures since they target different gene sequences.

Applicant respectfully traverses. There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent (see MPEP § 802.01, § 806.04 and § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and (B) There must be a serious burden on the Examiner if restriction is required (see

MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02). The term “independent” (*i.e.*, not dependent) means that there *is no disclosed relationship* between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect. (Emphasis supplied, MPEP § 802.01).

Applicant submits that antisense oligonucleotides directed to human neuropilin genes, to mouse neuropilin genes or to rat neuropilin genes are not “independent” subjects as defined in MPEP § 802.01. Such antisense oligonucleotides are connected in design (*i.e.* they are selected according to specific disclosed criteria; for example, see 15, lines 1 – 5 and Table 1, including footnotes), in operation (*i.e.* they are capable of binding to the target neuropilin gene sequence; see for example, page 20, lines 15 – 17) and in effect (*i.e.* they inhibit neuropilin gene expression; see, for example, page 12, lines 3 – 4). Applicant asserts that claims 1 – 30, directed to antisense oligonucleotides to human, mouse and rat neuropilin genes, compositions comprising the antisense oligonucleotides and methods of using the antisense oligonucleotides are thus related and form a single invention.

Moreover, MPEP § 803 states that “[i]f the search and examination of an entire application can be made without serious burden, the Examiner *must* examine it on the merits, even though it contains claims to distinct or independent inventions.” (Emphasis supplied).

Applicant submits that the claims of Groups I, II and III are connected by a single, searchable unifying relationship (*i.e.* antisense oligonucleotides that inhibit neuropilin gene expression). In view of this single, searchable unifying relationship, Applicants submit that the Examiner would not be seriously burdened by searching and examining the claims of these groups in a single application.

In conclusion, Applicant asserts that the claims of Groups I, II and III are connected in design, in operation and in effect and, therefore, should be examined together. Applicant further submits that the claims are connected by a single, searchable unifying relationship, and that the

In re Application of
Wright et al.
Application No. 09/296,264
Filed: April 22, 1999
Page 4

PATENT
Attorney Docket No.: MBM1250-2

Examiner would not, therefore, be seriously burdened by searching and examining the claims of these groups in a single application. Accordingly, Applicant requests withdrawal of the restriction of claims 1 – 30.

In the event that the above arguments are not persuasive, Applicant elects Group I, with traverse, consisting of Claims 1 – 30, drawn to antisense to human neuropilin gene, including SEQ ID NO:33, and compositions comprising said antisense and methods of using said antisense.

Claim 24 stands further restricted under 35 U.S.C. 121 and 37 C.F.R. 1.141. The Examiner has indicated that the Applicant is required to elect up to 10 antisense sequences from claim 24. The Examiner asserts that each of the antisense sequences in claim 24 is considered to be structurally independent and distinct even though they each target the same human neuropilin gene, because each targets a different and specific region of the gene. The Examiner further asserts that a search of all the antisense sequences of claim 24 presents an undue burden on the Patent and Trademark Office.

Applicant respectfully traverses. As indicated above, the claimed antisense oligonucleotides are connected in design, in operation and in effect. Furthermore, the antisense oligonucleotides of claim 24 share common structural and functional characteristics in that they all target the same neuropilin gene and they all inhibit growth of cancer cells. Applicant asserts that the antisense oligonucleotides of claim 24 are further connected by a single, searchable unifying relationship (*i.e.* their ability inhibit neuropilin gene expression) and thus do not present an undue burden on the Patent and Trademark Office to search and examine all these sequences in a single application. Applicant accordingly requests withdrawal of the restriction of claim 24.

In the event that the above arguments are not persuasive, Applicant elects, with traverse, the following sequences from claim 24: SEQ ID NOs. 1, 2, 3, 5, 6, 8, 9, 10, 11 and 12.

In re Application of
Wright et al.
Application No. 09/296,264
Filed: April 22, 1999
Page 5

PATENT
Attorney Docket No.: MBM1250-2

CONCLUSION

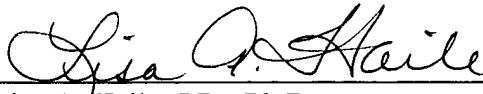
On the basis of the foregoing remarks, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. §121. Applicant respectfully submits that the claims currently on file are ready for examination and in condition for allowance.

On the basis of the foregoing claim amendments and remarks, Applicants respectfully submit that, upon entry, the pending claims will be in condition for allowance. If there are any questions regarding these amendments and remarks, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Please charge any additional fees, or make any credits, to Deposit Account No. 50-1355.

Respectfully submitted,

Date: October 2, 2002



Lisa A. Haile, J.D., Ph.D.

Reg. No. 38,347

Telephone: (858) 677-1456

Facsimile: (858) 677-1465

GRAY CARY WARE & FREIDENRICH LLP
4365 Executive Drive, Suite 1100
San Diego, California 92121-2133
USPTO Customer Number: 28213